



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,601	01/30/2001	Thomas W. Poplawski	P/2167-247	1711

7590 01/30/2004

MICHAEL J. SCHEER
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICA, 41 ST FLOOR
NEW YORK,, NY 10036-2714

EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872601

Applicant(s)

Roplaugh

Examiner

Ayers, g

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/8/04
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

Response to Request for Continued Examination(RCE)

1. This action is issued in response to applicant's Request for Continued Examination(RCE) (Paper # 9) filed 1/8/04.
2. Claims 1,19,24,29 were amended. No claims were deleted. None were added.
3. Claims 1-32 as newly amended, are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 as amended, are rejected under 35 USC 103(a) as unapentable over Schutzer(US Pat.No: 6,292,789) in view of Hilt(US Pat. No: 5,465,206) and further in view of OLeary(US Pat. No:6,609,113).
6. As per amended claims 1-32 Schutzer teaches a method for effectuating electronic bill presentment(Abstract)(Figs 1-32) through at least one biller(Fig 3) over the internet(Fig 2/116) and e-mail containing billing information(Fig 7/152).Schutzer further teaches a consumer service provider(Fig 7), and a billing service provider(Fig 7) and a payment engine(Fig 7) and a payment processor(Fig 7). Schutzer further teaches statement contents(Fig 30) consisting of billing data

Art Unit: 3624

and remittance information (Fig 30). Schutzer also teaches presentment and payment (Fig 32/206) and security (Fig 32/212) in e-commerce transactions. In addition to that taught by Schutzer, Hilt also teaches banks acting as customer service providers (Abstract) (Figs 4-12) for the payment of bills over a payment network (Fig 7) (Fig 8) as well as a billing database (Fig 4/108). Hilt also teaches a biller who maintains a general ledger of all accounts (Fig 4/14/42) as well as a universal biller reference file (Fig 6/106), as well as a customer bill invoice (Fig 7/120) (Fig 11/250) and a bill pay order (Fig 7/122) (Fig 9/210) as well as a payment network with a payment e-message (Fig 8/124) (Fig 12/124) in the bill pay system (col 17 line 19-col 22 line 27). Hilt further teaches a payment message (Fig 4/124) and a bill pay order (Fig 6/122). Hilt further teaches debiting and crediting banks settlement accounts on EFT (Fig 11/256). In addition to that taught by Hilt, O'Leary further teaches a physical receipt feature for paid bills (col 5 line 24-26) as well as secure access to a home page on the internet by a browser based technology or thin client technology to access the database server (Fig 2/200/205/210/227/215). O'Leary further teaches a complete means for effectuating electronic funds transfer messages (Abstract) including an Internet pay anyone account (Abstract). O'Leary further teaches a purchase record (Fig 2/250) a payment record (Fig 2/245) payment confirmation (Fig 2/244) as well as an electronic wallet (Fig 3/315) and a payment record (Fig 3/345) and (Fig 3/3L) bill payment. O'Leary further teaches electronic funds transfer messaging for activities (Fig 5/270) and the use of a virtual private lockbox (Fig 7/735). It would have been obvious to one skilled in the art to combine Schutzer in view of Hilt and further in view of O'Leary to teach applicant's invention. The motivation

Art Unit: 3624

Schutzer in view of Hilt is to teach an electronic bill presentment and payment system utilizing e-mail notices and which incorporates banks as customer service providers as enunciated by Hilt(col 10 lines 30-62). Furthermore, the motivation to combine Schutzer in view of Hilt and further in view of OLeary is to teach an electronic billing and payment system utilized over the Internet with secure and save access to the database server via the network as enunciated by OLeary(col 4 lines37-47) which provides an integrated internet billing and data processing communication system for brower based computer subscribers.

Response to Arguments

7. Applicant's arguments filed 1/8/04 have been fully considered but are moot in view of the new additional grounds of rejection.

Conclusion

8. THIS ACTION IS MADE NON-FINAL.

9. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the

Application/Control Number: 09/772601

Page 5

Art Unit: 3624

status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.


January 23, 2004

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER